

REMARKS

Claims 5 and 6 were objected to as being dependent upon a rejected base claim. By this amendment, the limitation of claim 5 has been moved into claim 1, and claim 5 has been canceled. New claims 16-29 include the limitations of allowable claim 6.

Claims 9 and 10 were rejected under 35 U.S.C. §103(a) over Kroop et al. in view of Palmiter et al. The Examiner concedes that Kroop et al. does not disclose handles on the box or back panel of a writing pad, nor does Kroop disclose aligned handles which present a through-hole in overlying registration. The Examiner addresses this deficiency through the combination of Kroop with Palmiter, arguing that it would have been obvious to provide Kroop with handles "since such a modification would allow the portable receptacle to be carried our transported easily." Applicant takes issue with this conclusion.

Firstly, it is well settled that in rejecting claims under 35 U.S.C. §103, the Examiner must provide a reason why one having ordinary skill in the pertinent art would have been led to combine the cited references to arrive at Applicant's claimed invention. There must be something *in the prior art* that suggests the proposed combination, other than the hindsight gained from knowledge that the inventor choose to combine these particular things in this particular way. Uniroyal Inc. v. Rudkin-Wiley Corp., 837 F.2d 1044, 1051, 5 USPQ2d 1434, 1438 (Fed. Cir. 1988). The Examiner is also required to make specific findings on a suggestion to combine prior-art references. In Re Dembeczak, 175 F.3d 994, 1000-01, 50 USPQ2d 1614, 1617-19 (Fed. Cir. 1999).

In addition, a combination of references cannot be used in such a way that the intended purpose of the primary reference is defeated. Such would be the case in this situation. Reference is made to column 7, lines 40+ of the '689 patent to Kroop et al., where it is described that "one skilled in the are [sic] will appreciate that, where the kit contains four wings, there are thirty-six partially open positions and twenty-four closed positions possible." Thus, one of the stated goals of Kroop et al. is to have multiple wings, with various folding configurations to add to the interest and complexity of the product so that the user does not "get bored." Thus, apart from the fact that Kroop neither discloses nor suggests handles, it is unclear where they would be put given all these various folding combinations. Accordingly, prima facie obviousness has not been established. New claims 57-70 include a limitation

similar to that in claims 11 and 14, namely, that the box has front, back and side panels defining two front edges and two back edges, and wherein the back panel of the pattern book is hinged to one of the front or back edges of the box. Although claims 11 and 14 were rejected under 35 U.S.C. §102(b) over Kroop et al., Applicant believes that this is in error, since the "box" of Kroop does not include a front panel. Rather, the wings fold over the box to hold the contents therein. Anticipation may be established only when a single prior art reference discloses, expressly or under principles of inherency, each and every element of a claimed invention. RCA Corp. v. Applied Digital Data Systems, 730 F.2d 1440, 1444, 221 USPQ 385, 388 (Fed. Cir. 1984). Moreover, anticipation requires the presence of all elements of a claimed invention as arranged in the claim, such that a disclosure "that 'almost' meets that standard does not 'anticipate'." Connell v. Sears, Roebuck Co., 722 F.2d 1542, 1548, 220 USPQ 193, 198 (Fed. Cir. 1983). In this case, given that Kroop does not disclose a box with a front panel, anticipation is defeated, and this set of claims should be deemed allowable as well.

With respect to the rejection of claim 4 (and claims added by this amendment) under 35 U.S.C. §112, second paragraph, regarding writing implements of a "color-changing type," Applicant contends that although not specifically disclosed in the specification, such a term would be immediately apparent to anyone of skill in the art. Attached herewith is a page of a Google search performed by the undersigned, including the expression "color change markers." As the Examiner will see, all of the results on the page speak to various color-change markers provided by companies such as Crayola, and others. It is further noted that Applicant's invention is directed to a kit, and not necessarily to the types of materials or markers stored therein. In other words, "color-changing markers" do not represent any point of novelty, insofar as Applicant's kit may utilize any type of color-changing markers, which are ordinarily based upon a change in pH to change one color to another, or clear to a particular color.

Based upon the foregoing amendments and comments, Applicant believes all claims are in condition for allowance. Questions regarding this application may be directed to the undersigned via telephone or facsimile to expedite prosecution.

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